

The claims remaining in the application are 1-3, 6-7, 10-13, 16-17 and 20.

REMARKS

The Applicants would like to thank the Examiner for the quick and courteous final Office Action.

Rejection under 35 U.S.C. §102(b) Over Dougherty, et al.

The Examiner has rejected all of the claims 1-3, 6-7, 10-13, 16-17 and 20 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pat. No. 5,582,792 to Dougherty, et al. The Examiner contends that Dougherty, et al. discloses adding maleated fatty acids neutralized with diethoxylated alkyl amine (tertiary amine) and is added to a fluid in an amount of 25 to 1000 ppm of said fluid. The Examiner alleges that the drag reducing function and an amount of the additive effective to reduce drag would have been inherent to the methods and compositions of Dougherty, et al. since the methods and compositions read on and allegedly otherwise anticipate the additive, method steps and concentrations for use as a corrosion inhibitor.

In response to the Applicants' arguments, the Examiner finds that the Applicants asserted that the claims as amended are no longer anticipated by the Dougherty, et al. reference. The Examiner did not deem this persuasive because while the claims no longer recite the limitation of "alkoxylated amine salts of", said claims do recite and read on the limitation to "tertiary amine salts of" as disclosed by the Dougherty, et al. reference.

The Applicants must respectfully traverse. A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir.), cert. denied, 116 S.Ct. 516 (1995).

The Examiner's attention is respectfully directed to the amendments to independent claims 1, 7, 11 and 17 herein, and dependent claims 3 and 13 where the recitation of tertiary amines has been deleted. The diethoxylated tertiary amines of Dougherty, et al. are alkoxylated tertiary amine salts of this definition, and thus are excluded from the claims herein by the amendments to the claims 1, 3, 7, 11, 13 and 17. Thus, because a single prior art reference does not disclose each and every limitation of the claims, it is

respectfully submitted that the claims as amended are not anticipated by Dougherty, et al. Support for these changes is found in the application as filed at original dependent claims 4, 8, 14 and 18 (now cancelled), and page 5, lines 21-25 in paragraph [0019] and thus do not constitute improper insertions of new matter.

It is respectfully submitted that because each and every limitation of the claim is not taught by the single prior art reference, the amended claims are not anticipated thereby. Reconsideration is respectfully requested.

Request for Entry of Amendment

The Applicants would respectfully submit that the instant Amendment be entered under 37 CFR 1.116(b): "Amendments presenting rejected claims in better form for consideration on appeal may be admitted." It is respectfully noted that the affected claims have been amended herein to resolve the only issue left in the prosecution, and to overcome the rejection. Thus, the only issue remaining has been removed from contention. It is respectfully submitted that for this reason, which completely simplifies the remaining issue, the instant Amendment should be entered.

It is respectfully submitted that the amendments and arguments presented above overcome all of the rejections. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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